

II. Remarks

A. Introduction

Reconsideration and allowance of the present application are respectfully requested. Claims 1-5, 8, 10-16, 19, and 21-40 are pending in the present application. Claims 1, 12, and 23 are independent. Claims 1-5, 8, 10-12, and 23 have been amended. Claims 29-40 have been added. No claims have been cancelled. No new matter has been introduced.

Support for the amendments to claims 1 and 12 is found in the specification on page 16, lines 7-21 (table 1), pages 20 and 21 (table 2), and page 32, line 13 to page 33, line 34 (table 6), as well as elsewhere throughout the originally filed specification and claims. Support for new claims 29-40 is found in the specification on page 16, lines 7-21 (table 1), and page 32, line 13 to page 33, line 34 (table 6), as well as elsewhere throughout the originally filed specification and claims.

B. Interview

The Examiner is thanked for the courtesies extended to Applicants' representatives during the November 30, 2007 Interview. During the interview agreement was reached that the rejections may be overcome by showing that the claims include unexpected results that are commensurate with the scope of the specification. Applicants' separate record of that interview is contained herein.

C. Claim Rejections

1. Rejection of Claims 1-3, 10, 12-14, and 21 under 35 U.S.C. § 103(a) is Improper Because the Office Action Failed to Provide Evidence to Support the Combination of References

Independent claims 1 and 12, and dependent claims 2, 3, 10, 13, 14, and 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over GB2193972 to Csikos et al. (hereinafter "Csikos") in view of U.S. Patent No. 5,498,809 to Emert, et al. (hereinafter "Emert"), and in further view of U.S. Patent No. 4,925,582 to Bennett, et al. (hereinafter

“Bennett”). This rejection is traversed by the following arguments.

The Office Action has failed to provide evidence to support the combination of references in the manner set forth in the Office Action. The Office Action completely failed to provide any evidence to support or even mention how Csikos would be combined with Emert and Bennett. The US Supreme Court requires that evidence to support the combination of references should be made apparent. *KSR Int’l Co. v. Teleflex Inc.*, 550 US ___, 127 S.Ct. 1727, 1741 (2007) (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). The USPTO emphasized the importance of providing evidence in the recent guidelines regarding obviousness. (72 Fed. Reg. 57,527 (Oct. 10, 2007) (“Factual findings made by Office personnel are the necessary underpinnings to establish obviousness.”)).

The Office Action stated that Csikos “discloses a composition containing an antioxidant; but does not disclose the specific types of antioxidants.” (See Office Action, page 2). Emert is only cited for disclosing antioxidants, including alkylated phenylenediamine antioxidants, in lubricating compositions. To support this combination the Office Action states on page 3 that the combination is obvious because the combination would “inhibit the deterioration of mineral oils.”

In addition, the Office Action stated that Csikos “discloses a metalworking fluid containing a biocide, but does not disclose the specific biocides recited.” (See Office Action, page 3). Bennett is only cited for teaching specific biocides. To support this combination the Office Action states on page 3 that the combination is obvious “for the purpose of reducing or inhibiting the growth of microorganisms.”

As clearly shown, the Office Action made two separate combinations, neither of which can independently teach the entire claim, and failed to provide any evidence that supports the combination of Csikos, Emert and Bennett in the matter set forth in the Office Action. Instead, the Office Action improperly dissected the claim into two

components and failed to evaluate the claim as a whole. *See W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1548, (Fed. Cir. 1983). This is evident by the fact that the Office Action has not set forth any evidence that a person of ordinary skill in the art would substitute, with predictable results, the antioxidants in Csikos with the antioxidants of Emert together with the biocides of Csikos and the biocides of Bennett. Nothing in Csikos teaches or suggests that the combination of antioxidant and biocide are related or are present in amounts sufficient to reduce oxidative and biological degradation as claimed. Csikos states that the “carrier mineral oil distillate does not need any oxidation inhibitor since the organic polysulphide contains active sulphur.” (*See* Csikos, page 2, lines 48-49). The antioxidant of Csikos supplements the polysulphide and Csikos discloses no relationship with the biocide. Emert cannot remedy this deficiency, since no biocides are disclosed with the various antioxidants. Bennett cannot remedy the deficiencies of Csikos and Emert, since potentiating agents, specifically alkanolamines, are used in combination with the biocide. (*See* Bennett, Col. 3, lines 20-22; and Col. 4, lines 5-18). The Office Action has not made of record any reason for combining all three references, and has only made two combinations based on an improperly dissected claim.

Further, the Office Action has improperly used Applicants’ disclosure as a road map to find elements of the claims in three separate references without evidence to support the combination of those references. *See Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1275 (Fed. Cir. 2004). As stated above, the Office Action alleges that all the elements of the claims are present among three separate references and combines all three references without any evidence as to why one skilled in the art would be motivated to do so. Absent objective evidence, the Federal Circuit has stated that such rejections can be reasonable assumed to be based on hindsight, i.e. using Applicants’ disclosure as a road map. *See In re Rouffet*, 149 F.3d 1350, 1358 (Fed. Cir. 1998). Therefore, this rejection should be withdrawn.

In sum, the combination of Csikos, Emert and Bennett is made without the required factual evidence, improperly dissected the claims, and improperly used Applicants’ disclosure as a roadmap, and thus should be withdrawn.

2. Unexpected Results Provided by Specification Overcomes the Improper Combination of References to Reject Claims 1-3, 10, 12-14, and 21

In addition to the improper combination of references of Csikos, Emert and Bennett, independent claims 1 and 12 overcome the rejection because the specification provides a showing of unexpected results. The Federal Circuit stated that a combination of references may be overcome by showing “that the claimed invention exhibits some superior property or advantage that a person of ordinary skill in the relevant art would have found surprising or unexpected.” *In re Soni*, 54 F.3d 746, 750 (Fed. Cir. 1995). The specification states that “although the samples containing (0.25%) biocide and (0.25%) antioxidant might be expected to ‘break’ after 3 to 4 weeks, a synergy was found where the mixed samples lasted 5 weeks (see Table 6).” (Specification, page 32, lines 19-21). This evidence clearly supports the conclusion that the results were unexpected. Also the unexpected results are superior to the comparative examples that only used a biocide. As stated in *In re Soni*, “when an applicant demonstrates substantially improved results... and states that the results were unexpected, this should suffice to establish unexpected results in the absence of evidence to the contrary.” 54 F.3d at 751. The Office Action has not set forth any evidence to the contrary. Therefore, the rejection of independent claims 1 and 12 is overcome based on the unexpected results set forth in the specification, and this rejection should be withdrawn.

3. Rejection of Claims 1-3, 10-14, 21 and 22 under 35 U.S.C. § 103(a) is Improper Because the Office Action Failed to Provide Evidence to Support the Combination of References

Independent claims 1 and 12, and dependent claims 2-3, 10, 11, 13, 14, 21 and 22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Csikos, Emert, and in further view of U.S. Patent No. 5,981,632 to Fields (hereinafter “Fields”). This rejection is traversed for similar reasons as discussed above. Field is only used to teach additional biocides and Fields cannot remedy the deficiencies of Csikos and Emert. Therefore, this rejection should be withdrawn.

4. Unexpected Results Provided by Specification Overcomes the Improper

Combination of References to Reject Claims 1-3, 10-14, 21 and 22

In addition to the improper combination of references of Csikos, Emert and Fields, independent claims 1 and 12 overcome that rejection because the specification provides a showing of unexpected results as discussed above. Therefore, this rejection should be withdrawn.

5. Rejection of Claims 23-28 under 35 U.S.C. § 103(a) is Improper Because the Office Action Failed to Provide Evidence to Support the Combination of References

Independent claim 23 and dependent claims 24-28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Csikos, Emert, Fields, and in further view of two press releases from Crompton Corporation, dated January 7, 2003, and October 30, 2001. This rejection is traversed for similar reasons as discussed above.

Crompton Corporation Press Release of January 7, 2003 is cited by the Office Action as a reference available under Section 102(b). However, the present application claims priority to a provisional application filed on April 8, 2003. Thus, this press release is not available under Section 102(b).

The Crompton Corporation Press Releases are only cited for teaching specific antioxidants and cannot remedy the deficiencies of Csikos, Emert, and Fields. Further no evidence is provide for combining all five references in manner set forth in Independent Claim 23. Therefore, the rejection of Independent Claim 23 should be withdrawn.

6. Rejection of Claims 23-25 and 27 under 35 U.S.C. § 103(a) is Improper Because the Office Action Failed to Provide Evidence to Support the Combination of References

Independent claim 23 and dependent claims 24, 25 and 27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Csikos, Emert, Bennett, and in further view of U.S. Patent No. 6,348,514 to Calabrese (hereinafter "Calabrese"). This rejection is traversed for similar reasons as discussed above.

The Calabrese is only cited for teaching specific antioxidants and cannot remedy the deficiencies of Csikos, Emert, and Fields. Further no evidence is provide for combining all four references in manner set forth in Independent Claim 23. Therefore, the rejection of Independent Claim 23 should be withdrawn.

7. Rejection of Claims 23 and 24 under 35 U.S.C. § 103(a) is Improper Because the Office Action Failed to Provide Evidence to Support the Combination of References

Independent claim 23 and dependent claim 24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Csikos, Emert, Bennett, and in further view of U.S. Patent No. 6,075,065 to Yamazaki, et al. (hereinafter "Yamazaki"). This rejection is traversed for similar reasons as discussed above.

The Yamazaki is only cited for teaching specific antioxidants and cannot remedy the deficiencies of Csikos, Emert, and Fields. Further no evidence is provide for combining all four references in manner set forth in Independent Claim 23. Therefore, the rejection of Independent Claim 23 should be withdrawn.

8. Rejection of Claims 23 and 24 under 35 U.S.C. § 103(a) is Improper Because the Office Action Failed to Provide Evidence to Support the Combination of References

Independent claim 23 and dependent claim 24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Csikos, Emert, Bennett, and in further view of U.S. Patent No. 4,624,679 to McEntee (hereinafter "McEntee"). This rejection is traversed for similar reasons as discussed above.

The McEntee is only cited for teaching specific antioxidants and cannot remedy the deficiencies of Csikos, Emert, and Fields. Further no evidence is provide for combining all four references in manner set forth in Independent Claim 23. Therefore, the rejection of Independent Claim 23 should be withdrawn.

9. Unexpected Results Provided by Specification Overcomes the Improper Combination of References to Reject Claims 23-28

In addition to the improper combination of references of Csikos, Emert, Fields, Crompton Corporation Press Releases, Calabrese, Yamazaki and McEntee, independent claim 23 overcomes that rejection because the specification provides a showing of unexpected results as discussed above. Therefore, this rejection should be withdrawn.

10. Dependent Claims

Dependent claims 4, 5, 15, and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Csikos, Emert, Bennett, and in further view of two press releases from Crompton Corporation, dated January 7, 2003, and October 30, 2001. Dependent claims 4 and 15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Csikos, Emert, Bennett, and in further view of Calabrese. Dependent claims 8 and 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Csikos, Emert, Bennett, and in further view of Yamazaki. Dependent claims 8 and 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Csikos, Emert, Bennett, and in further view of McEntee.

The dependent claims contain all the limitations of the independent claims from which they depend and thus are patentable over the cited reference for at least the same reasons as the independent claims.

D. Conclusion

In view of the above remarks, it is believed that this application is in condition for allowance, and a Notice thereof is respectfully requested.

Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 625-3536. All correspondence should continue to be directed to the below-listed address.

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